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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,312	02/07/2006	George Tidmarsh	021305-003610US	8919
20350 7590 02/14/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER MOHAMED, ABDEL A				
ART UNIT		PAPER NUMBER		
1654				
MAIL DATE		DELIVERY MODE		
02/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/542,312

Applicant(s)

TIDMARSH ET AL.

Examiner

ABDEL A. MOHAMED

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7, 9, 11, 13-16 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 4, 5, 7, 9, 11, 13-16 and 21-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

ACKNOWLEDGEMENT TO THE PRELIMINARY AMENDMENT AND THE STATUS OF THE CLAIMS

The preliminary amendment filed 07/15/05 is acknowledged, entered and considered. In view of Applicant's request claims 5, 7, 9, 11, 13-15 and 29 have been amended and claims 2, 3, 6, 8, 10, 12 and 17-20 have been canceled. Claims 1, 4, 5, 7, 9, 11, 13-16 and 21-30 are active and pending in the application.

ELECTION/RESTRICTION

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 4, 5, 7, 9, 11 and 13-16, drawn to a method of use of energolytic agent (EA) for treating or preventing benign prostatic hypertrophy (BPH).

Group II, claim(s) 21-28, drawn to first screening assay of a compound to treat BPH.

Group III, claim(s) 29 and 30, drawn to second screening assay of a compound to treat BPH.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The methods of Groups I-III, each has different scope, they are directed to various methods of using the compound (i.e., energolytic agent) for different purposes. Although, Inventions I-III are related, the end results for the aforementioned treatment are divergent and a search conducted for one would not necessarily overlap with a search conducted for another. Further, Inventions I-III each differ from the other in method of treating, or preventing and/or screening assay steps, parameters and purposes used, and as such, one does not require the other for ultimate use and effect. Thus, the various methods using the same compound (i.e., energolytic agent) as recited above do not correspond to the same technical feature and are not connected in design, operation or effect because they differ in method steps, parameters and reagents used, and as such, the methods as grouped are different from each other because they represent different technical features and different inventive endeavors. For example, Group I is directed to method of treatment or preventing using EA and method of making EA; however Groups II and III are directed to first and second screening assays respectively. Thus, the groups require different patent and literature search and a reference teaching treatment or prevention of BPH will not teach screening assays and *vice versa*. Therefore, Groups I-III does not share the same technical features, the inventions do not relate to a single inventive concept.

CONCLUSION AND FUTURE CORRESPONDANCE

Claims 1, 4, 5, 7, 9, 11, 13-16 and 21-30 are subject to restriction/election requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABDEL A. MOHAMED whose telephone number is (571)272-0955. The examiner can normally be reached on First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohamed/AAM
February 6, 2008

/Jon P Weber/
Supervisory Patent Examiner, Art Unit 1657